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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,620	01/09/2002	Jason C. Gilmore	47079-0129	4385
30223	7590	03/11/2005	EXAMINER	
JENKENS & GILCHRIST, P.C.			MOSSER, ROBERT E	
225 WEST WASHINGTON				
SUITE 2600			ART UNIT	PAPER NUMBER
CHICAGO, IL 60606			3714	

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/042,620	GILMORE ET AL. <i>ED</i>
	Examiner	Art Unit
	Robert Mosser	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 10-28-2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-31 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 09 January 2002 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) The translation of the foreign language provisional application has been received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) Notice of References Cited (PTO-892)
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

4) Interview Summary (PTO-413) Paper No(s). _____.
5) Notice of Informal Patent Application (PTO-152)
6) Other: _____

DETAILED ACTION

♦

In response to the amendment and arguments dated October 28th, 2004.

♦

Claims 1-31 are pending.

♦

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 28th, 2004 has been entered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-31 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 3 of U.S. Patent No. 6,800,027. Although the conflicting claims are not identical, they are not patentably distinct from each other because as broadly understood claim 3 allows for the unlocking of a feature in a second game resultant of meeting a criteria in a first wagering game. As the patented claim 3 in USP 6,800,027 is broader then the presently presented claims the presently presented claims would by necessity infringe. In the present application this correlates to base game triggering a bonus game as shown through example in instant claims 1 and 5 through dependency thereon. Where the patented claim 3 language “...if a status of the first wagering game meets a predetermined criteria, unlocking an otherwise unavailable feature of a second wagering game such that the feature is available to the player.” is understood to encompass a triggering event in the first game which in turn would allow the player to play a second game and the second game is correlated to a previously unavailable feature.

Regarding Independent claims 1, 11, 21, 26, and 31, the previously patented claim 3 is substantially similar to the present claims including the features of a first and second game however, is silent regarding the particular game being a selection game containing a plurality of selectable elements associated with a plurality of selectable elements or a slot based game. This use of a selection game however notoriously well known and demonstrated by Moody et al (US 5,976,016) as addressed in the rejection under USC 102 below. It would have been obvious for one of ordinary skill in the art at the time of invention to choose selection of slot based game for the first and second

game of USP 6,800,027 in order to incorporate game types envisioned in USP 6,800,027.

Further patented claim 3 is silent regarding the use or non-use of non-selected elements however, Moody et al (US 5,976,016) teaches this feature as addressed in the rejections below. It would have been obvious to one of ordinary skill in the art at the time of invention to base an award off of non-selected elements in order to maintain game suspense after the selection process.

Remaining feature present in dependent claims **2-9, 12-20, 22-25, and 27-30** including the revealing of elements, the inclusion of payoffs, the visual associated of reel symbols with the display area, the determination of awards based on both selected and non-selected elements, use of animated patterns, and use of a video display are considered well known features in gaming and evidence of such has been provided for in the rejections under USC 102 and USC 103 below under Moody et al (US 5,976,016) individually and in combination with Schneider et al (US 6,089,976).

The office records indicate common assignment of both the instant application and the patented case USP 6,800,027 presently. While this rejection may be overcome through applicant submitted evidence clearly demonstrating that both the application and patent were not commonly assigned as originally filed. Such a submission however, would merely provide basis for application of the US 6,800,027 patent under the criteria set forth by USC 102(e) in future rejections.

Drawings

The communication filed March 26th, 2004 notes the inclusion of replacement drawings, however no such document is presently associated with the case. Resubmission of the described figure is suggested.

This was noted in the previous final action mailed June 21st, 2004.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 and 11-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al (US 5,976,016).

Regarding at least claims 1-3, 8, 11-13 and 18. Moody et al discloses a multi-line slot machine method including the receiving of wagers from players, displaying to the player on a first row of the slot machine a plurality of symbols, allowing the player to select which of the symbols to hold, and generating random replacement symbols for the symbols not held, and awarding a prize according to the symbols and the pay table (Figures 1-3 & Col 1:33-48). Thus, in response to a wager the player selects the symbols to hold and the award is determined by the combination of these selected and adjacent non-selected symbols along the pay line providing the respective reward outcomes in accordance with the pay table. This correlates to at least the displaying of

a plurality of selectable elements, each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes, wherein the Selectable element is the symbol hold indicator for each respective column and the Respective outcomes are represented with the initial game selection of symbols shown in figure 1.

Regarding at least claims **4** and **14**, Moody et al teaches the payout dependent on multiple combinations with associated payouts or an award payoff as so described (Col 4:10-24).

Regarding at least claims **5**, **7**, **15**, and **17**, Moody et al teaches the awarding a bonus round or a bonus game as so described resultant of a special combination being obtained in the method described previously (Col 6:16-28).

Regarding at least claims **6** and **16**, Moody et al teaches the use of traditional mechanical slot wheels that are stacked vertically and are rotated vertically before being stopped in vertical association with the display area (Col 6:49-64).

Regarding at least claims **9** and **19**, Moody et al teaches the display of a plurality of selectable elements in a matrix including a plurality of rows and columns and wherein at least one of the non-elected elements for which the outcome is awarded includes a plurality of the non-selected elements adjacent to the selected element (Figures 1-3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al (US 5,976,016) as applied to claims 1 and 11 above, and further in view of Schneider et al (US 6,089,976).

Moody et al is silent as to the use of an animated pattern encompassing the selected element in response to the selection. Schneider et al teaches the use of an animated pattern for the purpose of removing all of the elements that have not been selected and the elements that have been selected but do not form a pair (Figures 2-5 & Col 4:47-63). It would have been obvious for one of ordinary skill in the art at the time of invention to have utilized the animated pattern of Schneider et al in the invention of

Moody et al in order to emphasize the winning combinations and play lines that contain these combinations.

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US 6,089,976).

Regarding at least claims 21 and 26, Schneider et al teaches a method for a game of chance on a gaming machine including receiving a wager from a player (Col 4:29-40), conducting a primary game, starting a secondary game response to a start-secondary game outcome in the primary game, and starting a primary game response to a start-primary game outcome in the secondary game (Figure 7). The start outcomes are understood as the qualifying outcome and the outcome of matching two rewards in the secondary game of Schneider. Schneider however teaches his secondary game and primary game in an opposite configuration. It would have been obvious to one of ordinary skill in the art at the time of invention to have interchanged the primary game and secondary game of Schneider in order create a game with a guaranteed percentage wager return and a chance at a jackpot prize. The game mechanics of the primary and secondary game of Schneider are not the same mechanics. In addition it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to win a / qualify for a free primary game in the secondary game in similar manner as taught by Schneider for qualifying in a primary game for the secondary, in order maintain a player's interest in utilizing the device.

Regarding at least claims **22, 23, 27, and 28**, Schneider et al teaches his previously secondary game as including interactive selection wherein the player selects an element and receives the award associated with the selection of an element prior to selecting at least one more element (Col 2:65-3:16 & Figures 2-4). As stated above the previously primary game of Schneider et al is understood as the secondary game of the applicant while the previously secondary game of Schneider et al is understood as the primary game of the applicant.

Regarding at least claims **24, 25, and 31**, and in addition to the above stated in the rejection of claims **21-23** and **26-28**. Schneider et al teaches the use of a slot reel game including a plurality of symbol bearing slot reels that are rotated and stopped to place a symbols on the reels in visual association with a display area in his previously primary game (Col 5:9-33 & Figure 1).

Regarding at least claims **29** and **30**. Schneider et al teaches the step of conducting a primary slot game including awarding a payout based on the symbols displayed in the display area of a video display (Col 5:20-33 & Col 2:57-64).

Response to Arguments

Applicant's arguments filed 3-26-2004 have been fully considered but they are not persuasive.

First the applicant's response fails to present any reasoning or arguments to support the presence of any novel features in their claims as newly amended. They have been addressed on merit alone in the interest of furthering prosecution. Standing

rejections have been modified to address the subject matter of the applicant's amendments presented after the filling of the after final amendment on 8-27-2004.

Previously present arguments submitted with the filling of the above cited after final maybe found in the advisory action mailed 9-23-2004.

Amendments to claims **1** and **11** are correlated in the following manner:

Each one of a plurality of selectable elements corresponds to symbol positions in 311-315 figure one.

Corresponding to one of a plurality of respective outcomes corresponds to the symbols randomly determined in location 311-315 selected from the possible symbols available for selection.

Amendment to claim **12** from the player is shown in the transition from figure 1 to figure 2. Said transition is dependent on the selection by the player of the first three columns.

With regards to amendment s to claims **21-31**, their features have been addressed in the newly presented rejections above. However these features also seem at this point to utilize the same game mechanics as taught by Schneider merely rearranged. As presented in the rejection above this rearrangement of first and second games is considered to be well within the realm of obviousness to one of ordinary skill in the art.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris H Banks can be reached on (571) 272-4419. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM



JESSICA HARRISON
PRIMARY EXAMINER